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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,635	04/02/2004	Alexander James Tod Denoon	HYD001US	9553
24011	7590	04/15/2008		EXAMINER
SILVERBROOK RESEARCH PTY LTD				STIBBLEY, MICHAEL R
393 DARLING STREET				
BALMAIN, 2041			ART UNIT	PAPER NUMBER
AUSTRALIA				4194
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,635	Applicant(s) DENOON ET AL.
	Examiner MICHAEL STIBLEY	Art Unit 4194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 April 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-40 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 April 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449/68)
Paper No(s)/Mail Date 2/12/2007, 11/20/2006, 11/01/2004.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

1. This Office Action is in response to the application filed on April 2, 2004. Claims 1-40 are pending and have been examined. Examiner relies on 2002/0046104 A1, cited in Applicant's IDS, therefore it will not again be cited on Form 892.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 14, 15, 22, 36, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. As to Claims 14, 15, and 22 "GPS" should apparently be -global positioning system-. While GPS is widely known, acronyms should be avoided and are confusing.

5. As to Claims 36, "EPC" could mean anything from Electronic Product Code to Environmental Protection Commission. Applicant should spell out what EPC stands for and not use acronyms, as they are confusing.

6. As to Claim 39, "determining that the article has not been used to obtain the inducement" is a negative limitation and does not make sense considering that in claim 1, the coded data disposed on or in a surface of an article, would be use of the article to obtain the incentive or inducement and claim 39 is dependent on Claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 4-5, 8-17, 20-23, 25, 27-36, and 40 are rejected under 35

U.S.C. 102(b) as being anticipated by KADDECHE ET AL (KADDECHE) (US

2002/0046104 A1).

9. AS PER CLAIMS 1-2, 4-5, 8-17, 20-23, 25, 27-36, and 40: KADDECHE teaches a method, and corresponding computer system of providing a user with information about a product or service, via machine-readable coded data disposed on or in a surface of an article, the method comprising the steps, performed in a computer system, of: "...computer..." ¶3, "...computers..." ¶4, 19 "...servers..." ¶19, 22, 25, 44, 64 "...server..." abstract, Fig.3, ¶14, 20, 22, 23, 24, 25, 27, 29, 30, 34, 44, 45, 47, 48, 51, 52, 53, 55, 56, 64, 65, 66, 67, 69 "...internet..." Figs. 1, 2, 3, ¶3-6, 9-11, 16, 19-20, 23, 25-26, 29, 44-47, 49-50, 64-66 "...wireless device..." Fig 3, ¶6-8, 15, 20, 35, 44-45, 47, 52, 55, 51, 64, 65, 67, 69 "...mobile..." ¶20 "...network..." Figs 1-3, ¶3, 6, 8, 19-21, 24, 47, 52, 56, 69 "...telecommunications..." ¶19 "...network operator (operators)..." ¶20, 21, 47

10. receiving interaction data representing interaction of a sensing device with the coded data, the interaction data having been generated at least partially on the basis of at least some of the coded data being sensed by the sensing device as the interaction took place; "...GPS..." Fig 3, ¶7, 15, 20, 29, 31, 35, 47, 69 "...bar code (reader)..." ¶67, 69 "...scanning..." ¶67 "...(commercial)(advertising) impression(to the internet client)(to the subscriber)(providers)..." ¶15, 24, 25, 26, 32, 34, 35, 44, 49, 56, 64

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11. receiving location data indicative of a geographical location; "...geographic location (based)(data)(information)... ¶¶7, 15, 20, 25, 29, 31, 35, 36, 44, 47, 48, 51, 54, 56, 64, 69 (*wherein a location is inherently an area, defined by a postal or zip code, defined as a city, suburb or town, and for this method to work, the area would have to be defined by a transmission footprint of one or more cells of telecommunications network--*)
12. determining, from the location data and the interaction data, the information; "...(commercial)(advertising) impression(to the internet client)(to the subscriber)(providers)(indicative of location of commercial entity)... ¶¶15, 24, 25, 26, 32, 34, 35, 44, 49, 56, 64 "...advertisement (the information)... " abstract, ¶¶12, 14, 23, 26, 33, 49, 50, 54, 55, 71 "...advertisements..." ¶¶3, 6, 7, 50 "...ad..." ¶¶5, 6, 44, 56, 64 "...ads..." ¶¶5, 6, 9, 10, 11, 49 "...Burger King (number of outlets)... ¶¶54 "...a store..." (only valid for particular location) ¶¶54
13. providing the information to the user. "...subscriber (user)..." abstract, ¶¶6, 7, 14, 15, 20, 21, 22, 24, 33, 35, 36, 37, 44, 47, 48, 51, 52, 54, 55, 56, 57, 64, 65, 67, 71 "...subscribers..." ¶¶22, 29, 31, 32, 65, 70, 71 "...advertise(provide)..." abstract, 14, Claim 1 "...communicated (provide)..." ¶¶7, 67 "...user..." "...message regarding that day's special (discount) may also be provided to the subscriber..." ¶¶5 "...to alert the subscriber to the latest on-sale (discount) items at the store near the subscriber..." ¶¶36 "...prizes or coupons for shopping..." ¶¶21 "...user..." ¶¶20, 21, 25, 26, 28, 30, 36 "...users..." ¶¶4, 9, 10, 22, 46, 49 "...purchase..." ¶¶67 "...identity..." ¶¶22- 23, 47-48, 51-56, 70 "...identifier..." abstract, ¶¶14 "...id..." ¶¶52

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. **Claims 18, 19, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over KADDECHE ET AL (KADDECHE) (US 2002/0046104 A1) in view of YILIN ZHAO, (ZHAO) “Mobile Phone Location Determination and Its Impact on Intelligent Transportation Systems” IEEE Transactions on Intelligent Transportation Systems, Vol. 1, No. 1, March 2000.**

17. **AS PER CLAIMS 18, 19, 24, and 26: KADDECHE generally teaches the methods of Claims 18, 19, 24 and 26, as the reasoning of the rejections of Claims 1-2, 4-5, 8-17, 20-23, 25, 27-36, and 40 is incorporated herein because the limitations of the instant claims are substantially similar.**

18. **KADDECHE does not specifically teach wherein the sensing device includes a wireless receiver for receiving radio-frequency data from a transmitter, the radio-**

frequency data including location information upon which the location data is based. Or wherein the location data having been derived using an Uplink Time Difference of Arrival technique.

19. **HOWEVER ZHAO** does teach wherein the sensing device includes a wireless receiver for receiving radio-frequency data from a transmitter, the radio-frequency data including location information upon which the location data is based. Or wherein the location data having been derived using an Uplink Time Difference of Arrival technique.

ZHAO PP55-63.

20. **THEREFORE**, it would have been obvious to a person having ordinary skill in the art at the time of the invention to combine the teachings of KADDECHE with ZHAO **thereby** providing for location based promotions and advertising.

21. **Claims 3, 6, 7, 37, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over KADDECHE ET AL (KADDECHE) (US 2002/0046104 A1) in view of BARNES, JR. (BARNES) (US 2003/0065805 A1).**

22. **AS PER CLAIMS 3, 6, 7, 37, 38, and 39: KADDECHE** generally teaches a method of providing a discount capable of being printed to a consumer with a wireless mobile device, as discussed in the reasoning of the rejections of claims 1-2, 4-5, 8-17, 20-23, 25, 27-36, and 40, the reasoning of the rejections of these claims incorporated herein as the instant limitations are substantially similar.

23. **KADDECHE** does not specifically teach: wherein the providing step includes causing a printer to print the information in the form of a voucher for obtaining the discount; wherein the determining step includes determining that the article has been

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purchased; wherein the price discount is only valid at an outlet of a commercial entity at the location; wherein the price discount is valid at any of a number of outlets of the commercial entity; or determining that the article has not been used to obtain the inducement

24. **HOWEVER, BARNES** does teach: wherein the providing step includes causing a printer to print the information in the form of a voucher for obtaining the discount; "...print the coupon (print module)(print device)(print agent)(print)(print advertisement)..." ¶¶243, 244, 349, 367, 380, 420 "...printing..." ¶¶126-127, 268, 349, 367, 380 "...printer..." 50-51, 126, 243, 329, 380 wherein the determining step includes determining that the article has been purchased; "...purchased..." ¶¶1210, 217, 253, 260, 258, 263, 285, 286, 290, 292, 390, 396, 405, 417, 424, 431 wherein the price discount is only valid at an outlet of a commercial entity at the location; "...vender store location..." ¶¶7, 12, 100, 231, 243, 260, 257, 276, 277, 283, 293, 294, 297, 389 wherein the price discount is valid at any of a number of outlets of the commercial entity. "...chain or franchise..." ¶¶283, 298 "...locations..." ¶¶32, 82, 100, 159, 217, 230, 231, 238, 264, 272, 294, 326, 393, 437, 478 and determining that the article has not been used to obtain the inducement "...determine..." Fig 4, Fig 5, Fig 6, Fig 8, ¶¶65, 70, 72, 74, 75, 81, 97, 98, 151, 159, 163, 165, 180, 184, 100, 101, 108, 113, 121, 188, 220, 224, 231, 256, 259, 264, 267, 294, 297, 299, 303, 304, 313, 325, 326, 332, 336, 348, 360, 415

25. **THEREFORE**, it would have been obvious to a person having ordinary skill in the art at the time of the invention to combine the teachings of BARNES with KADDECHE, **thereby** providing for location based promotions and advertising.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL STIBLEY whose telephone number is (571)270-3612. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michael Stibley/
Examiner, Art Unit 4194
Tuesday, April 15, 2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4194